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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/732,914

12/11/2000

David Cheo

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07/31/2006

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EXAMINER

KETTER, JAMES S

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 09/732,914 | Applicant(s) CHEO ET AL. | |
| | Examiner James S. Ketter | Art Unit 1636 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,8,22,35-37,40-42,47-54,69,77-100,103-123 and 143-150 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22,35,36,40-42,47-54,69,77-100,103-119 and 145-150 is/are allowed.
- 6) ☒ Claim(s) 7,8 and 120-123 is/are rejected.
- 7) ☒ Claim(s) 143 and 144 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/12/05, 1/19/06</u> | 6) <input type="checkbox"/> Other: _____ |

A review of the prosecution has led to the reinstatement of a number of rejections previously withdrawn. The delay in so doing is regretted. Consequently, the previously indicated allowability of claims 7, 8, 120-123, 143 and 144 is withdrawn. Claims 143 and 144 are actually objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The disclosure is objected to because of the following informalities: At page 249, line 20, there is a nucleotide sequence lacking the required embedded sequence identifier (i.e., "SEQ ID NO:...").

Appropriate correction is required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined

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was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 7, 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Scott et al. (A), for reasons of record set forth in the Office Action mailed 1 July 2002.

At the paragraph bridging pages 11 and 12 of the amendment filed 2 January 2003, Applicants argue that the instant invention is drawn to recombining populations of molecules, in contrast to single DNA constructs, as taught by Scott et al. However, upon reconsideration of this point, and a search of the instant specification, it is not clear how a population is defined in a manner that excludes a solution of a plurality of molecules which are identical. At <http://dictionary.reference.com/browse/population>, population is defined:

“pop·u·la·tion... (pŏp'yə-lā'shən) *n.*

1. All of the people inhabiting a specified area.
 - a. The total number of such people.
2. The total number of inhabitants constituting a particular race, class, or group in a specified area.
3. The act or process of furnishing with inhabitants.
4. Ecology. All the organisms that constitute a specific group or occur in a specified habitat.
Statistics. The set of individuals, items, or data from which a statistical sample is taken.

Also called **universe**.

...

Source: *The American Heritage® Dictionary of the English Language, Fourth Edition*
Copyright © 2000 by Houghton Mifflin Company.
Published by Houghton Mifflin Company. All rights reserved.”

Thus, it is not clear how a population is distinguished from a mere plurality of (identical) items, i.e., molecules.

Claims 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Piedrahita et al. (B), for reasons of record set forth in the Office Action mailed 1 July 2002.

At page 13, first paragraph, Applicants offer substantially the same argument as discussed above against the rejection under 35 USC §102(b) Scott et al., which already has been addressed above.

Claims 120-123 are rejected under 35 U.S.C. 102(e) as being anticipated by Winter et al. (D), for reasons of record set forth in the Office Action mailed 1 July 2002.

At page 16, first paragraph, Applicants offer substantially the same argument as discussed above as against the rejection under 35 USC §102(b) Scott et al., which already has been addressed above. Equally, the comments above apply to the instant arguments against Winter et al.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scott et al. (A) or Piedrahita et al. (B), either taken in view of either Hodges et al. (E) or Baszczyński et al. (F), for reasons of record set forth in the Office Action mailed 1 July 2002.


At page 20, first full paragraph, Applicants offer substantially the same argument as discussed above against the rejection under 35 USC §102(b) Scott et al., which already has been addressed above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Ketter whose telephone number is 571-272-0770. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached on 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JSK
19 July 2006



JAMES KETTER
PRIMARY EXAMINER